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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/083,492	02/27/2002	David Farcot	P21987	8439

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EXAMINER

BOTTORFF, CHRISTOPHER

ART UNIT	PAPER NUMBER
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3618

DATE MAILED: 12/17/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/083,492

Applicant(s)

FARCOT ET AL. 

Examiner

Christopher Bottorff

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 21 October 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

The amendment filed October 21, 2002 has been entered. Claims 6-20 have been added. Claims 1-20 are pending.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on October 21, 2002 have been approved. A proper drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The correction to the drawings will not be held in abeyance. — done #6

Specification

The amendment filed October 21, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: "whereby the screw 30 is in screw-threaded engagement with the hole 51 while the threaded portion 57 is positioned within the hole 51," in paragraph 0041, and "whereby the screw 73 is in screw-threaded engagement with the hole 103 while the threaded portion 102 is positioned within the hole 103," in paragraph 0061.

On lines 1-5 of page 9 of the remarks to the amendment, Applicants contend that support for these limitations is found in the paragraphs immediately following the

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amended paragraphs. That is, paragraphs 0042 and 0062 respectively. Paragraph 0062 is substantially the same as paragraph 0042. Paragraph 0042 states:

"It is thus possible to mount the screw 30 on the plate 50 by forcibly screwing it until the smooth portion 56 reaches the hole 51. After screwing, the threaded portion 57 is located on the other side of the plate 50 with respect to the head 55 and with respect to the disk 20."

However, if the threaded portion of the screw is located on the other side of the plate, then the threads are not engaged with any portion of the plate, including hole 51. Thus, the new limitations are not consistent with the original disclosure. According to the original disclosure, the screw is mounted on the plate by placing the smooth portion into the hole, and allowing the threads to extend beyond the plate to engage the board.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 7-20 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 7, lines 11-12, and claim 13, lines 10-11, indicate that the screws are in threaded engagement with the plate. However, this is inconsistent with the original disclosure, as discussed in the objection to the specification above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Keller et al. US 5,909,893 in view of Tanaka US 6,386,574.

Keller et al. discloses an assembly for retaining a boot on a sports apparatus. See figure 3; column 2, lines 44-50; and column 4, lines 6-29. The assembly has a disk 1 that retains a base, wherein the disk includes four elongated holes 10 that extend through the disk in its thickness, are parallel to one another, are aligned in pairs, are elongated in the same direction, and are across from one another. Also, two generally rectangular plates 12 that are parallel to the disk are housed in a cavity 11 of the disk, wherein the cavity has a generally parallelepipedic contour. Each plate includes two holes 13 extending through the plate in its thickness and each plate slides along the length of the elongated holes. Screws 8 with threaded portions extend through the elongated holes of the disk and the holes of each plate.

While Keller et al. suggests that the disk is retained in a base, a base is not explicitly disclosed. In addition, the plate is not square with four holes spread to the four corners of the square and is not located on the lower portion of the disk.

However, Tanaka teaches that the practice of providing a disk 72 in a base 14 of a boot-retaining apparatus was old and well known in the art at the time the invention was made. See figure 1 and column 2, lines 44-45. From the teaching of Tanaka, providing the assembly of Keller et al. with a base would have been obvious to one of ordinary skill in the art at the time the invention was made. Such a modification would allow the assembly to receive the sole of a boot.

In regard to the generally square shape of the plate, providing the plate of Keller et al. in a generally square shape with holes at the corners, rather than two rectangles with holes at the ends, represents an obvious design choice that was within the purview of one of ordinary skill in the art at the time the invention was made. This modification would reduce the number of parts in the assembly. Moreover, in paragraph 0037 on page 7 of the specification Applicants state that the shape of the plate is not a critical feature.

Furthermore, arranging the plate on the lower portion of the disk, rather than in a cavity of the disk, represents an obvious reversal of parts. It is well settled that merely reversing the parts of an apparatus is an obvious expedient. See *In re Gazda*, 104USPQ 400 (CCPA 1955).

Response to Arguments

Applicant's arguments filed October 21, 2002 have been fully considered but they are not persuasive.

Applicants assert that the apparatus of Keller et al. does not always necessitate the use of the plates and that one of ordinary skill in the art is directed to use a disk with many holes without regard to the presence of plates. However, the embodiment of Keller et al. depicted in figure 3 includes plates, and therefore directs one of ordinary skill in the art to use plates. The presence of additional mounting holes is irrelevant since the present claims do not exclude such holes.

The embodiment of Keller et al. depicted in figure 3 discloses all of the features defined in the independent claims of the present invention, except the base. The base is suggested on lines 49-51 of column 2 of Keller et al. and is explicitly taught by Tanaka. In addition, the shape and location of the plate defined in the dependent claims is obvious, as discussed in the rejection above.

In regard to the arguments presented at the top of page 11, Keller et al. uses the same retaining means for retaining the screws on the plate as the retaining means disclosed by Applicants in paragraphs 0042 and 0062 of the disclosure. Furthermore, the obvious change to a square shaped plate would necessarily involve all of the screws extending through the one plate.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Stevens, Carenter et al. US 5,261,689, Carpenter et al. US 5,356,170, Metzger et al., Erb, Perlman, Bayer et al., Beran, Lee, and Tanaka US 6,206,402 disclose boot-retaining assemblies. Note that Perlman US 5,791,678 teaches a square plate retained in a cavity of a disk.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Bottorff whose telephone number is (703) 308-2183. The examiner can normally be reached on Mon.-Fri. 7:30 a.m. - 4:00 p.m..


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Johnson can be reached on (703) 308-0885. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-7687 for regular communications and (703) 305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.



Christopher Bottorff
December 2, 2002



BRIAN L. JOHNSON
SUPERVISORY PATENT EXAMINER
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12/16/02